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B2 764. (New) A textile-based amusement article according to claim 45 and further comprising an odor-absorbing agent selected from at least one of an activated carbon and a zeolite compound.

865. (New) A textile-based amusement article according to claim 45 wherein of the outer casing is impregnated with a flame resistant modacrylic polymer.

A "marked-up copy" of amended claim 45 is enclosed herewith as exhibit A.

#### REMARKS

By the present amendment, claim 45 has been amended and new claims 59-65 have been added as claims dependent on claim 45. Claims 60-65 are patterned after cancelled claims 8-11, 17 and 18. Support for the amendment to claim 45 and for new claim 59 is found in the specification as filed, page 14, lines 1-4. No new matter has been added.

In the Office Action, claims 19-44 and 47-55 have been withdrawn from consideration. The remaining claims, claims 45, 46, 56-58 have been rejected. Reconsideration of the rejection of the elected claims 45, 46 and 56-58 is respectfully requested in view of the following remarks.

In the Office Action, claims 45, 46 and 56-58 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over the Plunk U.S. Patent No. 5,560,320 in view of the Seabrook et al. U.S. Patent No. 5,554,373. This rejection is respectfully traversed.

The Plunk '320 reference discloses a play and chew toy for dogs comprising a knotted rope portion and a soft squeezable fleece portion carried by the rope portion. The fleece portion includes an outer shell of a soft material which encases a supply of soft synthetic filler material and extends about one of the knots in the rope. Although not disclosed by Plunk '320, the squeezable fleece portion is believed to be a textile casing formed of a tough, chew resistant material which defines the shape in the form of a small article for luring or being fetched by a domestic animal and forming an artificial fleece. This reference is representative of the state of the art in animal chew toys.

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The Seabrook et al. '373 patent discloses molded products that can be used with agriculture products, food products and consumables and that have incorporated therein slow release, anti-microbial agents of organic bound arsenic (OBPA), also known as vinylzene and 2 - (4'-thiazolyl) benzimidazole (TBZ). Vitamin E is incorporated into the mixture for flow release of the anti-microbial agents. Seabrook et al. '373 further discloses that these compositions can be used in animal litter additives, animal litter container liners, veterinary products, among other things, and in particular, dental tubing. All of the article claims and all of the method claims require the use of one or more of the vitamin E, OBPA and TBZ.

The alleged combination of Plunk '320 and Seabrook et al. '373 is traversed. There is no basis for making the alleged combination. The articles and methods disclosed in these references are mutually exclusive and do not lend themselves to combinability as alleged by the Examiner. For example, the Plunk '320 patent relates to play and chew toys for dogs and does not relate to molded products which are the subject of the Seabrook et al. '373 patent. There is no hint in Plunk '320 of the desirability of incorporating an anti-microbial agent. The concept of adding an anti-microbial agent to a play and chew toy for dogs is completely absent from the Plunk '320 patent. Thus, Plunk gives no hint of the desirability of adding anything of any anti-microbial nature to a play or chew toy for dogs.

The Seabrook et al. '373 reference is equally void of any suggestion of the use of an anti-microbial agent in animal chew toys. It relates to the use of anti-microbial agents within synthetic molded products for protection against microbes. The Seabrook et al. anti-microbial agents are toxic and would not likely be used as an anti-microbial agent in an animal chew toy. The intention of Seabrook et al. '373 is to release the anti-microbial agents over a period of time. Accordingly, a dog may ingest the toxic anti-microbial agents if used in an animal chew toy.

Another reason why the references are not combinable is that there is no molded product in the Plunk '320 chew toy. The textile casing is not a molded product. Neither is the filling. Nor is the rope. The filling is said to be fiber filled materials. Thus, the alleged combination would not include any synthetic molded product into which the slow release anti-microbial agents of the Seabrook et al. '373 could be incorporated. There are no films, sheets or tubing in



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the Plunk '320 chew toy for incorporation of the Seabrook et al. '373 anti-microbial agents. The examiner has not cited any disclosure in either of these references as to how the Seabrook et al. '373 anti-microbial agents could be incorporated into the fiber filled, textile fleece casing animal toy of Plunk '320.

For all of the reasons, it would not be obvious to add the slow release anti-microbial agents of Seabrook et al. '373 to the Plunk '320 play and chew toy for dogs. A person having ordinary skill in the dog chew art would not likely look to the Seabrook et al. '373 reference for anti-microbial agents for a dog. Further, as indicated above, there is no suggestion in any of the references which warrant the alleged combination. Nor is there any basis given in the Office Action. There is not even a suggestion in any of the references of the desirability of incorporating anti-microbial agents into animal chew toys. Thus, the alleged combination of Plunk '320 with Seabrook et al. '373 is inappropriate to meet claims 45, 46, 56 and 58.

The standard for combining references in a patentability analysis under 35 U.S.C. § 103(a) is set forth recently in the case *In re Sang-Su Lee* 277 F.3d 1338; 61 USPQ2d (BNA) 1430 at pages 1342-1344 as follows:

As applied to the determination of patentability vel non when the issue is obviousness, "it is fundamental that rejections under 35 U.S.C. § 103 must be based on evidence comprehended by the language of that section." *In re Graselli*, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983). The essential factual evidence on the issue of obviousness is set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966) and extensive ensuing precedent. The patent examination process centers on prior art and the analysis thereof. When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. *See, e.g., McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) ("the central question is whether there is reason to combine [the] references," a question of fact drawing on the *Graham* factors).

"The factual inquiry whether to combine references must be thorough and searching." *Id.* It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. *See, e.g., Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion,

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teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding') (quoting C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); In re Dembiczak, 175 F.3d 994, 999 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."); In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); In re Fine, 837 F.2d 1071, 1075 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ("teachings of references can be combined only if there is some suggestion or incentive to do so.") (emphasis in original) (quoting ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

The need for specificity pervades this authority. See, e.g., In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of the ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

With respect to Lee's application, neither the examiner nor the Board adequately supported the selection and combination of the Nortrup and Thunderchopper references to render obvious that which Lee described. The examiner's conclusory statements that "the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial" do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the

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inventor taught against its teacher." W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion.


Like the Examiner in In re Sang-Su Lee, the issue of motivation to combine the references has not been adequately shown. Simply pointing out Applicants' disclosed solution to a problem or some speculative beneficial result of the combination does not meet the requirements of motivation to combine the references.

However, even if the alleged combination of Plunk '320 and Seabrook et al. '373 could be made, however untenably, it still would not reach Applicants' claimed invention. At best, the alleged combination would include the incorporation of the Seabrook et al. '373 slow release anti-microbial agents into polymeric films, sheets or tubing in the Plunk '320 chew toy.

Claim 26 distinguishes over the alleged combination of Plunk '320 and Seabrook et al. '373 in that it calls for an effective amount of a microbe-cidal agent applied to a textile casing. This element is not present in the alleged combination of Plunk '320 and Seabrook et al. '373. Further, claim 45 calls for the microbe-cidal agent to be non toxic and non carcinogenic when ingested by domestic animals at the levels used in the amusement article. This feature is also not found in the alleged combination of Plunk '320 and Seabrook et al. '373. Claims 46, 8-11, 17 and 18 depend from claim 45 and define over the alleged combination of references in the same manner as claim 45.

In addition, new claim 60 calls for the outer textile fabric to be treated with a compound to impart at least one of low surface energy, non-hydrophilic, antistatic properties and anti-adhesion properties. This concept is not disclosed in any alleged combination of references.

New claim 64 depends from claim 45 and calls for the textile based amusement article to include an odor-absorbing agent selected from one of an activated carbon and a zeolite compound. This element is also not disclosed in the alleged combination of Plunk '320 and Seabrook et al. '373.



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Likewise, new claim 65 calls for the outer casing to be impregnated with a flame resistant modacrylic polymer. This element is also not disclosed in the alleged combination of Plunk '320 and Seabrook et al. '373.

Claim 56 defines over the alleged combination of Plunk '320 and Seabrook et al. '373 in that it calls for a microbe-cidal agent applied to the textile casing in an effective amount. The alleged combination of references does not include the application of a microbe-cidal agent applied to a textile casing.

Claim 56 further defines over the alleged combination of Plunk '320 and Seabrook et al. '373 in that it calls for the microbe-cidal agent to be selected from at least one of the group consisting of heavy metal salts, halogenated dioxides, quaternary ammonium compounds, halogenated compounds, sulfur compounds, phenyl derivatives, phenoxy derivatives, thiazoles, chlorinated phenolic compounds, poly-substituted immine salts and phosphate esters, and mixtures thereof. None of these compounds are disclosed in the alleged combination of Plunk '320 and Seabrook et al. '373. In this connection, the Examiner has represented that Seabrook et al. '373 teaches a microbe-inhibiting agent in the form of 2, 4, 4'-trichloro-2'-hydroxydiphenol. Applicant has been unable to locate this disclosure in the Seabrook et al. '373 reference.

Claim 58 depends from claim 56 and defines over the alleged combination of references in the same fashion as claim 56 in that it calls for the microbe-cidal agent to be 2, 4, 4'-trichloro-2'-hydroxydiphenol. Applicant can find no disclosure of this compound in the Seabrook et al. '373 reference.

Claim 57 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Plunk '320 in view of Seabrook et al. '373, as applied to claim 56 above, and further in view of the Klatte U.S. Patent No. 5,558,543. This rejection is respectfully traversed.

The Klatte '543 patent discloses a method for producing chlorine dioxide by activating zeolite crystals which have been impregnated with metal chloride as sodium chloride and a water-retaining substance such as magnesium sulfate, potassium chloride, or potassium hydroxide, or calcium chloride (with an acid) or activating an aqueous solution of a metal chloride (preferably sodium chloride) and such a water-retaining substance. The activation can

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be performed by causing a fluid to flow through a bed of zeolite crystals impregnated with calcium chloride (or other water-retaining substance) and sodium chloride and a bed of zeolite crystals impregnated with the acid. Klatte '543 discloses that chlorine dioxide is useful for killing biological contaminants (such as microorganisms, molds, fungi, yeast and bacteria) and for oxidizing volatile organic chemicals which can contaminate fluid.

The significance of the Klatte '543 patent has escaped Applicants' attorney other than the fact that it discloses that chlorine dioxide is a microbe-inhibiting agent. Other than that, Klatte '543 appears to be totally irrelevant to the subject matter of Applicants' claims. Certainly, it is completely irrelevant to the disclosures in Seabrook et al. '373 and Plunk '320. There is absolutely no basis for making the alleged combination of Klatte '543 with Plunk '320 and Seabrook et al. '373 and the Examiner has given none. The rules of combining references is set forth in In re Sang-Su Lee, supra, are clearly not met by this alleged combination of references.

However, even if the alleged combination of references were to be made, however untenably, it still would not reach Applicants' claimed invention. Claim 57 depends from claim 56 and defines over the alleged combination of references in the same fashion as claim 56. In particular, the alleged combination of references would not include a microbe-cidal agent applied to the textile casing of Applicants' textile based amusement article. Thus, claim 57 patentably distinguishes over any alleged combination of Plunk '320, Seabrook et al. '373 and Klatte '543.

In view of the foregoing remarks and amendments, all of the claims are believed to be in condition for allowance. Early notification of allowability is respectfully requested.

Respectfully submitted,

Official

Matthew Denesuk and Eugenia V. Uhlmann

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By:

John E. McGarry, Reg. No. 22,360  
McGARRY BAIR LLP  
171 Monroe Avenue, NW, Suite 600  
Grand Rapids, Michigan 49503  
616-742-3500

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**EXHIBIT A - "MARKED-UP COPY" OF AMENDED CLAIM 45**

45. A textile-based amusement article to be played with, enticed or retrieved by a domestic animal comprising:

an outer textile casing formed of a tough, chew-resistant material defining a shape in the form of a small article for luring or being fetched by the domestic animal and comprising a high-pile component attached to a backing material to form an artificial fleece, the material formed in two layers sewn together at the edges with the high-pile component outwardly; and an effective amount of a microbe-cidal agent applied to the textile casing, wherein the microbe-cidal agent is non-toxic and non-carcinogenic when ingested by domestic animals at the levels used in the amusement article.

